

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-19 are presently active in this case; Claim 1 having been amended by way of the present amendment.

In the outstanding Office Action, Claims 1-5 and 8-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent number 5,477,508 to Will and Claims 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Will in view of U.S. patent number 4,024,678 to Portmann et al.

Applicants first note that Claim 1 has been amended to correct a typographical error. No new matter has been introduced.

Turning now to the merits, Applicants' invention is directed to a personal electronic device, such as a digital watch. As discussed in the Background section of the present application, consumer electronic devices, such as watches, mp3 players etc. typically have a large number of operating modes that appeal to a broad consumer base. However, such a large number of modes makes the electronic devices complex to operate. Applicants' invention is directed to addressing this problem.

Specifically, Claim 1 recites an electronic device having a case, an electronics module contained by the case and including at least a processor and a memory configured to store a plurality of available mode settings for the electronic device, and an input mechanism configured to provide input commands to the processor. Also recited is that the *processor is configured to, based on the input commands, configure the electronic device to provide a custom mode setting for a subset of the plurality of available modes*. Claim 19 includes similar limitations in mean-plus-function format. Claim 13 recites a method of setting custom modes in an electronic device, including operating an input mechanism of the

electronic device to initiate a custom mode setting sequence, and operating the input mechanism to select one of a plurality of available modes of operation of the electronic device. Also recited in Claim 13 is ***operating the input mechanism to toggle the selected mode on or off, wherein a mode toggled off is unavailable for use by a user of the electronic device.***

The Official Action cites Will as anticipating Claims 1-5 and 8-19 of the present application. To establish a *prima facie* case of anticipation under 35 U.S.C. § 102, a single prior art reference must describe each and every element as set forth in the subject claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Moreover, as required by MPEP 2143.03, "All words in a claim must be considered in judging the patentability of that claim against the prior art." Applicants respectfully submit that the cited reference to Will fails to teach each and every limitation of Claims 1, 13 and 19.

Specifically, FIG. 1 of Will discloses a digital watch having a main menu listing several menu items 6-10 that can be selected by the user. Will makes menu selection easier by providing the thumb wheel that the user can use to highlight a menu item. However, Will does not disclose that some of the menu items can be disabled to provide a custom watch that is simplified for particular users. Indeed, FIGs. 9-11 of Will show various screen shots of the digital watch depicting selection of the different modes of operation. Nowhere in Will is it suggested that some modes of operation be disabled.

Thus, Will does not disclose a device configured to, based on the input commands, configure said electronic device to provide a custom mode setting for a subset of the plurality of available modes as required by Claim 1 and Claim 19. Similarly, Will does not disclose

operating the input mechanism to toggle the selected mode on or off, wherein a mode toggled off is unavailable for use by a user of the electronic device, as recited in Claim 13. As described in the detailed description of the specification, it is these recited features that allow a device having a large number of modes to be tailored for a particular user to include only a few modes important to the user. Will simply does not disclose this feature. Thus, independent Claims 1, 13 and 19 patentably define over the cited reference to Will, and the rejection of Claims 1-5 and 8-19 as anticipated by Will should be withdrawn.

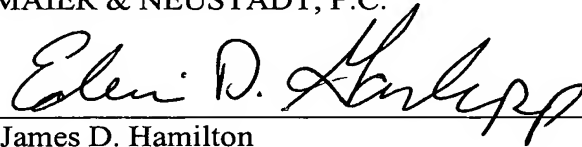
Regarding the rejection of Claims 6-7 as obvious over Will and Portmann et al., the Official Action cites Portman et al. for the teaching of a three button mode watch and not for the custom feature described above. Thus, Portmann et al. does not correct the deficiencies of Will and Claims 6-7 patentably define over the cited references for the reasons discussed above. Still further however, Applicants submit that there would be no motivation to combine Portmann et al. with Will to arrive at the present invention. The complexity of existing watches relates to their limited number of input buttons to initiate multiple operating modes. Will addresses this complexity problem by using a thumb wheel and a main menu to initiate the many operating modes. Portman et al. does not address the complexity problem at all. Thus, there is no disclosure in the cited references to even remotely suggest simplifying a three button watch by disabling some of the available operating modes as with the present invention. Thus, Claims 6-7 also patentably define over the cited references.

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Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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